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Docket No. 55293-A/JPW/AJM/MVM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Carlos Cordon-Cardo et al.

Serial No.: 09/329,917

Examiner: J. Souaya

Filed : June 10, 1999

Group Art Unit: 1634

For : MARKERS FOR PROSTATE CANCER

Date of Notice

of Allowance: July 23, 2002

Confirmation No.: 8767

Issue Fee Paid: October 23, 2002

1185 Avenue of the Americas  
New York, New York 10036  
November 12, 2003Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attention: Mr. Tom Hawkins

Sir:

**COMMUNICATION FORWARDING COPY OF MAY 14, 2003 REQUEST FOR  
RECONSIDERATION OF MARCH 17, 2003 DECISION ON PETITION  
PURSUANT TO 37 C.F.R. §1.137(e) AND CONTINGENT PETITION  
FOR WITHDRAWAL FROM ISSUE UNDER 37 C.F.R. §1.313(c)(2)**

On May 14, 2003, applicants submitted a Request For Reconsideration of March 17, 2003 Decision On Petition Pursuant To 37 C.F.R. §1.137(e) And Contingent Petition For Withdrawal From Issue Under 37 C.F.R. §1.313(c)(2), by Express Mail, to the United States Patent and Trademark Office ("USPTO") in connection with the above-identified application. Further to a November 12, 2003 telephone conference between Mr. Tom Hawkins of the Office of Patent Publications at the USPTO and Maria Marucci, Esq. of the undersigned attorney's office, Mr. Hawkins stated that according to his records, the May 14, 2003 Request was not received by the USPTO. Accordingly, Mr. Hawkins requested that applicants submit via facsimile, to his attention, a copy of the May 14, 2003 Request.

RECEIVED

MAR 10 2004

OFFICE OF PETITIONS

Applicants: Carlos Cordon-Cardo et al.  
Serial No.: 09/329,917  
Filed: June 10, 1999  
Page 2

In response, applicants transmit herewith as **Exhibit 1** a copy of the Request For Reconsideration which applicants timely submitted to the USPTO on May 14, 2003, as indicated by a signed Express Mail Certificate of Mailing. The Request includes **Exhibit I** (Amendment After Notice of Allowance Pursuant To 37 C.F.R. §1.312, including Exhibits A-B), **Exhibit II** (a copy of a postcard bearing the stamp of the USPTO confirming receipt of the Amendment on October 29, 2002), and **Exhibit III** (a Petition For Withdrawal From Issue Under 37 C.F.R. §1.313(c)(2), including a copy of: (i) a 2 page RCE Request Transmittal dated February 28, 2003 (in triplicate), (ii) a February 28, 2003 Communication And Supplemental Information Disclosure Statement). Mr. Hawkins stated that applicants need not resubmit Exhibits A, B and 1-19 of Exhibit III since they were previously submitted to the USPTO in connection with applicants' February 28, 2003 Petition and should still be in the file. Accordingly, Exhibit III, which is transmitted herewith, excludes Exhibits A, B and 1-19.

As additional evidence of applicants' timely submission of the Request on May 14, 2003, applicants transmit herewith (i) a copy of the return postcard date-stamped received by the Office of Initial Patent Examination ("OIPE") of the USPTO with the date of May 14, 2003 (**Exhibit 2**); and (ii) a copy of the Express Mailing Label date-stamped by the United States Postal Service with the date of May 14, 2003 (**Exhibit 3**).

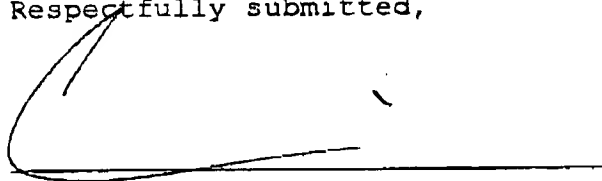
In view of the above facts, applicants respectfully request that (a) the May 14, 2003 Request be considered, (b) the holding of abandonment be withdrawn, (c) the February 28, 2003 Petition be considered and the subject application be withdrawn from issuance, (d) the RCE be accepted and (e) the Supplemental

Applicants: Carlos Cordon-Cardo et al.  
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Information Disclosure Statement be considered by the USPTO.

No fee, other than the \$505.00 fee previously submitted with applicants' May 14, 2003 Request, which includes the \$130.00 petition fee and the \$375.00 RCE filing fee, is deemed necessary in connection with the filing of this Communication. However, if an additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



John P. White  
Registration No. 28,678  
Alan J. Morrison  
Registration No. 37,399  
Attorneys for Applicants  
Cooper & Dunham LLP  
1185 Avenue of the Americas  
New York, New York 10036  
(212) 278-0400

EXHIBIT 1

Dkt. 55293-A/JPW/AJM/MVM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Carlos Cordon-Cardo et al.  
Serial No. : 09/329,917 Examiner: J. Souaya  
Filed : June 10, 1999 Group Art Unit: 1634  
For : MARKERS FOR PROSTATE CANCER

Date of Notice  
of Allowance: July 23, 2002 Confirmation No.: 8767

Issue Fee Paid: October 23, 2002

1185 Avenue of the Americas  
New York, New York 10036  
May 14, 2003

Office of Petitions  
Commissioner for Patents  
Crystal Plaza 4  
Suite CP4-3C23  
2201 South Clark Place  
Arlington, VA 22202

ATTN: Wan Laymon

SIR:

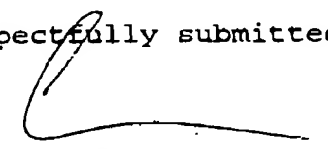
**EXPRESS MAIL CERTIFICATE OF MAILING**  
**FOR ABOVE-IDENTIFIED APPLICATION**

"Express Mail" mailing label number: EV 096 595 003 US  
Date of Deposit: May 14, 2003

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. §1.10 on the date indicated above and is addressed to the Office of Petitions, Commissioner for Patents, Crystal Plaza 4, Suite CP4-3C23, 2201 S. Clark Place, Arlington, VA 22202, Attention: Wan Laymon.

  
Printed Name John P. White

Respectfully submitted,

  
John P. White  
Registration No. 28,678  
Alan J. Morrison  
Registration No. 37,399  
Attorneys for Applicants  
Cooper & Dunham LLP  
1185 Avenue of the Americas  
New York, New York 10036  
(212) 278-0400

Docket No. 55293-A/JPW/AJM/MVM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Carlos Cordon-Cardo et al.  
Serial No.: 09/329,917 Examiner: J. Souaya  
Filed : June 10, 1999 Group Art Unit: 1634  
For : MARKERS FOR PROSTATE CANCER  
Date of Notice  
of Allowance: July 23, 2002 Confirmation No.: 8767  
Issue Fee Paid: October 23, 2002

1185 Avenue of the Americas  
New York, New York 10036  
May 14, 2003

Office of Petitions  
Commissioner for Patents  
Crystal Plaza 4  
Suite CP4-3C23  
2201 South Clark Place  
Arlington, VA 22202

ATTN: Wan Laymon

RECEIVED

MAR 10 2004

OFFICE OF PETITIONS

Sir:

REQUEST FOR RECONSIDERATION OF  
MARCH 17, 2003 DECISION ON PETITION PURSUANT  
TO 37 C.F.R. §1.137(e) AND CONTINGENT PETITION  
FOR WITHDRAWAL FROM ISSUE UNDER 37 C.F.R. §1.313(c) (2)

Applicants hereby request reconsideration pursuant to 37 C.F.R. §1.137(e) of a March 17, 2003 Decision on Petition which was issued by Mr. Tom Hawkins of the Office of Patent Publication at the United States Patent and Trademark Office ("USPTO") in connection with the above-identified application. 37 C.F.R. §1.137(e) provides a period of two months for filing a Request for Reconsideration. Therefore, a Request is due by May 17, 2003. Accordingly, this Request is being timely filed.

On December 9, 2002, a Notice of Abandonment was issued by the USPTO for failure to timely file formal drawings as required by a July 23, 2002 Notice of Allowability issued in connection with the subject application. In response, on January 28, 2003,

Applicants: Carlos Cordon-Cardo et al.  
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Filed: June 10, 1999  
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applicants timely filed a Petition Under 37 C.F.R. §1.181 To Withdraw Holding Of Abandonment, which included (i) a copy of applicants' October 23, 2002 Communication Forwarding Formal Drawings having attached thereto twelve sheets of new, corrected formal drawings, (ii) a copy of a certificate of mailing signed and dated October 23, 2002 and (iii) a copy of a postcard bearing the stamp of the USPTO confirming receipt of the Communication on October 29, 2002. The October 23, 2002 Communication was timely filed in that it was filed concurrently with payment of the issue fee.

In a February 28, 2003 telephone conference between Ms. Christina Connell of the Office of Petitions at the USPTO and Maria Marucci, Esq. of the undersigned attorneys' office, Ms. Connell stated that according to her records, the January 28, 2003 Petition was not received by the USPTO. Accordingly, on February 28, 2003, applicants submitted a Communication Forwarding Copy of January 28, 2003 Petition To Withdraw Holding Of Abandonment And Contingent Petition For Withdrawal From Issue Under 37 C.F.R. §1.313(c)(2) to the Office of Petitions.

In the March 17, 2003 Decision, the USPTO acknowledges receipt by first class mail on October 29, 2002 of the Communication Forwarding Formal Drawings, including twelve sheets of drawings attached thereto and a certificate of mailing signed and dated October 23, 2002 (37 C.F.R. §1.8). However, the Decision states that the October 23, 2002 Petition is dismissed because applicants allegedly did not respond to the Examiner's Amendment which accompanied the Notice of Allowability mailed by the USPTO on July 23, 2002. Therefore, the Decision states that the application was properly abandoned and the holding of abandonment will not be withdrawn at this time.

In response, applicants attach hereto as Exhibit I a copy of an

Applicants: Carlos Cordon-Cardo et al.  
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Filed: June 10, 1999  
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Amendment After Notice of Allowance Pursuant To 37 C.F.R. §1.312 which applicants timely submitted to the USPTO on October 23, 2002 (which includes substitute pages 7-14 of the specification as Exhibit A and a marked-up version of substitute pages 7-14 of the specification as Exhibit B and a signed first class certificate of mailing dated October 23, 2002). As additional evidence of applicants' timely submission of the Amendment on October 23, 2002, applicants attach hereto as **Exhibit II** a copy of a postcard bearing the stamp of the USPTO confirming receipt of the Amendment on October 29, 2002.

Contingent upon the positive disposition of applicants' Request for Reconsideration, applicants attach hereto as **Exhibit III** a copy of a Petition to Withdraw from Issue Under 37 C.F.R. §1.313(c)(2) which applicants submitted to the USPTO on February 28, 2003 in connection with the subject application. In the Petition, applicants request that the subject application be withdrawn from issue under 37 C.F.R. §1.313(c)(2) in consideration of a February 28, 2003 Request for Continued Examination ("RCE") in compliance with 37 C.F.R. §1.114, a copy of which applicants enclose herewith, so that references not previously of record which are set forth in a February 28, 2003 Supplemental Information Disclosure Statement, a copy of which is also enclosed herewith, may be considered by the Patent Office.

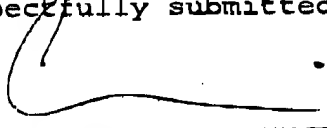
In view of the above facts, applicants respectfully request that (a) this Request for Reconsideration be considered, (b) the holding of abandonment be withdrawn, (c) the attached February 28, 2003 Petition to Withdraw from Issue be considered and the subject application be withdrawn from issuance, (d) the February 28, 2003 RCE be accepted and (e) the February 28, 2003 Supplemental Information Disclosure Statement be considered by the Patent Office.



Applicants: Carlos Cordon-Cardo et al.  
Serial No.: 09/329,917  
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No fee is deemed necessary in connection with the filing of this Request. Applicants note that they submitted a check in the amount of \$505.00 on February 28, 2003, which included the \$130.00 fee for the Petition to Withdraw from Issue and the \$375.00 RCE filing fee. If any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



---

John P. White  
Registration No. 28,678  
Alan J. Morrison  
Registration No. 37,399  
Attorneys for Applicants  
Cooper & Dunham LLP  
1185 Avenue of the Americas  
New York, New York 10036  
(212) 278-0400

Exhibit-I

**EXHIBIT II**

Applicant Carlos Cordon-Cardo, et al  
Client MSK (1747) File No. 55293-A Atty. JPW/AJM/HA  
Date October 23, 2002

Kindly acknowledge receipt of the accompanying  
AMENDMENT AFER NOTICE OF ALLOWANCE PURSUANT TO 37 C.F.R.  
§1.312 in connection with Carlos Cordon-Cardo et al., MARKERS FOR PROSTATE  
CANCER, U. S. Serial No. 09/329,917, filed June 10, 1999, including Exhibits A and  
B and a Certificate of Mailing dated October 23, 2002.

Date Due: October 23, 2002

by placing your receiving date stamp hereon and returning to us.

Applicant Carlos Cordon-Cardo, et al *SML*  
Client MSK (1747) File No. 55293-A Atty. JPW/AJM/HA  
Date October 23, 2002

Kindly acknowledge receipt of the accompanying  
AMENDMENT AFER NOTICE OF ALLOWANCE PURSUANT TO 37 C.F.R.  
§1.312 in connection with Carlos Cordon-Cardo et al., MARKERS FOR PROSTATE  
CANCER, U. S. Serial No. 09/329,917, filed June 10, 1999, including Exhibits A and  
B and a Certificate of Mailing dated October 23, 2002.

Date Due: October 23, 2002



by placing your receiving date stamp hereon and returning to us.

EXHIBIT III

Docket No. 55293-A/JPW/AJM/MVM

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants: Carlos Cordon-Cardo et al.

Serial No.: 09/329,917

Examiner: J. Souaya

Filed : June 10, 1999

Group Art Unit: 1634

For : MARKERS FOR PROSTATE CANCER

Date of Notice

of Allowance: July 23, 2002

Confirmation No.: 8767

Issue Fee Paid: October 23, 2002

1185 Avenue of the Americas  
New York, New York 10036  
February 28, 2003

Assistant Commissioner for Patents  
Washington, D.C. 20231

Attention: Office of Petitions

Sir:

**PETITION FOR WITHDRAWAL FROM ISSUE**  
**UNDER 37 C.F.R. §1.313(c)(2)**

Applicants hereby petition that U.S. Serial No. 09/329,917 in which the issue fee was paid on October 23, 2002, be withdrawn from issue under 37 C.F.R. §1.313(c)(2) in consideration of a Request for Continued Examination ("RCE") in compliance with 37 C.F.R. §1.114 which applicants enclose herewith so that references not previously of record which are set forth in a Supplemental Information Disclosure Statement, also enclosed herewith, may be considered by the Patent Office.

The required petition fee set forth in 37 C.F.R. §1.17(h) is ONE HUNDRED THIRTY DOLLARS (\$130.00) and a check including this amount is enclosed.

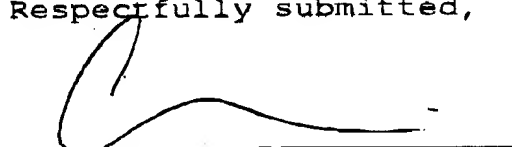
Applicants are petitioning that the subject application be withdrawn from issue so that references submitted in the

Applicants: Carlos Cordon-Cardo et al.  
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Filed : June 10, 1999  
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enclosed Supplemental Information Disclosure Statement for consideration may be considered by the Patent Office. Applicants do not believe that the references affect the patentability of the subject matter claimed in the subject application. However, in accordance with their duty of disclosure under 37 C.F.R. §1.56, applicants are requesting that the references be considered by the Patent Office.

No fee, other than the enclosed \$130.00 petition fee, is deemed necessary in connection with the filing of this Petition. However, if an additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



John P. White  
Registration No. 28,678  
Alan J. Morrison  
Registration No. 37,399  
Attorneys for Applicants  
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